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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,455	07/02/2003	Richard P. Ward	60,152-1002	5393

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EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,455

Applicant(s)

WARD ET AL.

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6 and 8-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restriction

Applicant's election with traverse of species A in the reply filed on 5 January 2005 is acknowledged. The traversal is on the ground that there are claims generic to both species. This is not found persuasive because the presence of generic claims does not make the restriction improper. Indeed, if a generic claim becomes allowable all the claims dependent therefrom will also be allowed regardless of the particular species to which they are directed.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4, 5, 7, 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-3, 6, 8-17 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,851,904. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are broader and all the features claim therein are found in the claims of the patent application.

Claims 1-3, 6, 8-17 and 21 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 10/439,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because, again, the claimed features in the instant application are broadly defined to where they are found in the claims of the parent application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6, 8-10, 12, 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, at the end of the fourth paragraph, it is unclear how the inclined *outer side wall* would provide a restricted

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opening adjacent the *pilot portion*. In each of claims 2, 3, 12 and 13 the intended limitation of "adjacent" is unclear because the independent claims from which they depend requires there to be a "space" thus giving essentially no meaning to the "adjacent" limitation. In claims 9 and 17, the characterizing of the bottom wall as "trapezoidal" is incorrect since a trapezoid requires straight sides whereas in the instant invention, the inner and outer walls are curved. The claims were examined as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Ross (US 2003/0039530 A1). In the embodiment of Fig. 3, Ross discloses a self attaching nut (10) having a pilot portion (13) and a flange (14) with a groove (12) formed therebetween. The groove includes inner and outer walls (not labeled) inclined inwardly forming a restricted opening to the groove (see Fig. 1) and including a plurality of circumferentially spaced ribs (25) integral with the outer side wall and having a top

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spaced from the bottom wall of the groove below the height of the flange (see Fig. 1) and having opposed planar side faces (the sides of the triangle as seen in Fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 8-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller (US 6,276,040) in view of Reusser (US 3,253,631). Müller discloses a self attaching nut (10) having a pilot portion (132) and a flange (142) with a groove (118) formed therebetween. The groove includes a perpendicular bottom wall along with inner and outer walls (not labeled) inclined inwardly forming a restricted opening to the groove (see Fig. 2) and including a plurality of circumferentially spaced ribs (164) integral with the outer side wall and having a top spaced from the bottom wall of the groove below the height of the flange (see Fig. 1). Müller does not disclose the shape of the ribs as claimed. Reusser discloses a similar type nut wherein a plurality of spaced radial ribs (13) forming a trapezoidal shape therebetween, each with an inclined planar top surface, extend integral with an outer side wall to a location beyond a mid portion of the groove and spaced "adjacent" to the inner side wall. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to from the ribs of Müller of a shape as disclosed in Reusser to provide improved

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resistance against rotation. Müller is not specific as to the shape of the ribs, other than being triangular in side view, and Reusser provides a rib specifically designed to prevent rotation which would have been recognized in Müller to provide improved resistance to rotation.

Claims 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusser (US 3,253,631) in view of Palmer (US 6,220,804). Reusser discloses a self attaching nut (1) comprising a central portion (7) and a flange (9) with a groove (10) formed therebetween. The groove having a "substantially" perpendicular bottom wall and an inclined inner side wall (at 12) forming a restricted opening and including a plurality of spaced radial ribs (13) forming a trapezoidal shape therebetween, each with an inclined planer top surface, extending integral with an outer side wall to a location beyond a mid portion of the groove and spaced "adjacent" to the inner side wall. Reusser discloses the ribs to have opposed planer side faces (15) but, does not disclose the side faces to be perpendicular with the bottom surface of the groove. Palmer discloses a similar type nut and teaches to have the side faces of the ribs (at 43) formed perpendicular to a bottom of the groove. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the side faces of the ribs in Reusser as perpendicular to a bottom surface of the groove as disclosed in Palmer in order to provide improved resistance to rotation. Indeed Palmer describes the perpendicular orientation as being preferred (column 6, lines 29-31).

Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller in view of Reusser and further in view of Palmer. Müller discloses a self attaching nut (10) having a pilot portion (132) and a flange (142) with a groove (118) formed therebetween. The groove includes a perpendicular bottom wall along with inner and outer walls (not labeled) inclined inwardly forming a restricted opening to the groove (see Fig. 2) and including a plurality of circumferentially spaced ribs (164) integral with the outer side wall and having a top spaced from the bottom wall of the groove below the height of the flange (see Fig. 1). Müller does not disclose the shape of the ribs as claimed. Reusser discloses a similar type nut wherein a plurality of spaced radial ribs (13), each with an inclined planer top surface, extend integral with an outer side wall to a location beyond a mid portion of the groove and spaced "adjacent" to the inner side wall. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the ribs of Müller of a shape as disclosed in Reusser to provide improved resistance against rotation. Müller is not specific as to the shape of the ribs, other than being triangular in side view, and Reusser provides a rib specifically designed to prevent rotation which would have been recognized in Müller to provide improved resistance to rotation. Müller as modified by Reusser discloses the ribs to have opposed planer side faces (15) but, does not disclose the side faces to be perpendicular with the bottom surface of the groove. Palmer discloses a similar type nut and teaches to have the side faces of the ribs (at 43) formed perpendicular to a bottom of the groove. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the side faces of the ribs in modified Müller as

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perpendicular to a bottom surface of the groove as disclosed in Palmer in order to provide still further improved resistance to rotation. In that regard, Palmer describes the perpendicular orientation as being preferred (column 6, lines 29-31).

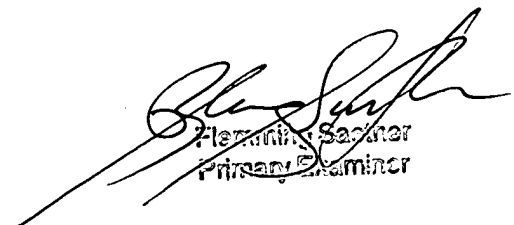
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Flemming Saether
Primary Examiner